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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,872	02/08/2001	Shusou Wadaka	2565-0225P	9099

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EXAMINER
BUDD, MARK OSBORNE

ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 05/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
778 872	Wadaka et al
Examiner	**Group Art Unit**
M. Budd	2834

---The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address---

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 5-2-02.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 17-60 is/are pending in the application.

Of the above claim(s) 17-23 and 41-60 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 24-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) 09/202070.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of References Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 24-33 and 40 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Krishnaswamy, Curran, Vale or Japan (804).

Each applied reference Curran (fig. 8), Vale (Figs. 1 & 2), Japan (204) (Fig. 4) and Krishnaswamy (Figs. 1-5 and 17) teach the specific structures claimed, although they don't necessarily teach the method steps used to produce the claimed structures. However, in product-by-process claims it is the product that must stand or fall on its own merits. The article is blind as to how it is produced. Method steps are irrelevant to the patentability of the article even in product-by-process claims. In re Thorpe 777 F. 2d 695.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan (804), Kirshnaswamy or Vale in view of Berlincourt.

Japan (804), Vale and Krishnaswmy teach the claimed acoustic device but do not provide a capacitor on the same substrate. However, Berlincourt teaches it is well known to integrate a capacitor onto a piezoelectric substrate to provide circuit integration and save space. Thus for at least these reasons it would have been obvious to one of ordinary skill in the art that Vale, Krishnaswamy and Japan could integrate a capacitor onto their piezo substrates.

Claims 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishnaswamy, Japan (804), Vale or Curran.

Each reference teaches the claimed structure except for the specific materials. However selection from among know suitable materials has long been held to be within the skill expected of the routineer. Each of the specific claimed materials is already well known as a substrate, piezoelectric transducer or electrode material (official Notice taken). Thus selection of any of these materials would have been obvious to one of ordinary skill in the art.

Applicant's traversal of the restriction requirement is noted. The method claims are classified in class 29 subclass 25.35. Thus, the search areas are not coextensive and a burden exists on the PTO if each separate invention were examined in a single application. Thus the restriction is seen to be proper and is hereby made final. Note too, that the same restriction requirement was made in the parent application Ser No. 09/202070.

Budd/ds

05/25/02

MARK O. BUDD
PRIMARY EXAMINER
ART UNIT 2834